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09/866,960	05/29/2001	Neil D. Scancarella	Rev 01-6	7403

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EXAMINER

OSTRUP, CLINTON T

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 10/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,960

Applicant(s)

SCANCARELLA ET AL.

Examiner

Clinton Ostrup

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-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on June 26, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-87 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 1-21 and 23-87 are pending in this application.

Response to Applicant's Declaration

The Declaration of Jean Manelski under 37 CFR 1.132 filed June 26, 2002 (Paper No. 9) is insufficient to overcome the rejection of claims 1-21 and 23-87 because it compares water dispersed pigmented compositions whereas the instant claims are all drawn to water and oil emulsions and for the reasons set forth in the last Office action because:

1. McDermott recognizes that compositions of their invention can be fabricated into a multitude of forms such as water-in-oil and oil-in water-emulsions to make creams and pastes;
2. McDermott teaches that the proportion of pigments used depends on the color and intensity of the color desired and that the pigments are selected from inorganic pigments, organic lake pigments, pearlescent pigments, and mixtures thereof; and
3. McDermott describes how the pigments may be surface-treated and teaches the specific inorganic and organic pigments of instant claims 5-8, 13, 31-33, 49-50, 67-68, and 82-83.

Therefore, the declaration is not convincing because it is comparing compounds that are not commensurate with what is being claimed, and the prior art recognizes that organic pigments can be used in water-in-oil and oil-in-water emulsions, and teaches that the specific pigments chosen depend on the color intensity desired. Moreover, it would be expected and obvious to one skilled in

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the art that compositions comprising organic pigments would be more vibrant than those containing inorganic pigments and that such vibrancy would be increased upon the addition of increased amounts of organic pigments. Thus, the rejections are being MAINTAINED for the reasons set forth in the Office Action mailed January 31, 2002 (Paper No. 5) and those found below.

Response to Applicant's Arguments/Amendment

Claim Rejections - 35 USC § 112, Second Paragraph

Applicant's amendment and arguments filed June 26, 2002 (Paper No. 8), to the rejection of claims 3-17, 21, 23-25, 27-29, 33, 41-44, 50, 58-61, 63-65, 76-78, 80 and 87 as being rejected under 35 U.S.C. 112, second paragraph, have been fully considered and deemed persuasive. Therefore, the said rejection has been withdrawn.

Claim Rejections - 35 USC § 103(a)

Applicant's amendment and arguments filed June 26, 2002 (Paper No. 8), to the rejection of claims 1-17, 21, 26-33, 35-37, 41, 45-50, 52-54, 58, 62-68, 70-72, and 79-85 as being rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott, **US 6,248,336 B1**, have been fully considered. However, the amendment and arguments are not found persuasive. Therefore, the said rejection has been MAINTAINED.

Applicants have responded to the rejection by breaking their claims into 6 different groups:

Group I, claims 1-29, which claim compositions containing organic pigments that are free of inorganic pigments.

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Group II, claims 30-47, which claim compositions containing inorganic and organic pigments dispersed in the oil phase of the emulsion where the organic pigment forms the main color component of the composition.

Group III, claims 48-65, which claim compositions containing organic pigments and inorganic pigments with organic pigment solubilized in the water phase and the inorganic pigment dispersed in the oil phase and the organic pigment forms the main color component of the composition.

Group IV, claims 66-80, which claim compositions containing organic pigments and inorganic pigments where the organic pigment is dispersed in the oil phase and the inorganic pigment in the water phase and the organic pigment comprises the main color component of the composition.

Group V, claims 81-85, which claim compositions containing organic pigments and inorganic pigments where both are solubilized in the water phase and the organic pigment comprises the main color component of the invention.

Group VI, claims 86-87, which claim compositions containing organic pigment which are free of synthetic and natural waxes.

First, it should be noted that only claims 1-17, 21, 26-33, 35-37, 41, 45-50, 52-54, 58, 62-68, 70-72, and 79-85 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDermott 6,248,336.

For Group I, claims 1-29, applicants argue that there is nothing in McDermott that teaches or suggests compositions that are free of inorganic pigments and that McDermott actually teaches away from the compositions of claims 1-17 because Examples I-V illustrate water-in-oil emulsion mascara

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compositions that contain black iron oxide in large amounts, which is exactly the opposite of claims 1-17. Applicants then submit that McDermott only teaches eyelash color with appreciable amounts of inorganic pigments.

In response to applicant's argument that there is no suggestion in the McDermott reference to make a composition that is free of inorganic pigments, the examiner respectfully disagrees. When considering the obviousness of modifying references, the examiner recognizes that obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, McDermott describes how "the make-up compositions of the present invention contain cosmetically acceptable pigments selected from the group of inorganic pigments, organic pigments, and pearlescent pigments."

Furthermore, the reference teaches that the pigments are present in proportions depending on the color and the intensity of the color which it is intended to produce." This suggests that the skilled artisan can easily and readily choose any desired pigments, including organic pigments with or without inorganic pigments, based on the color desired. Moreover, the reference clearly identifies organic pigment commonly used in cosmetic compositions. Although the water-in-oil emulsions in Examples I-V of the reference are not free of inorganic pigments, the test for obviousness is not what is taught in the specific examples, as this would be a 102 rejection, not a 103 rejection, the test of

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obviousness is what the teaching would have suggested to one having ordinary skill in the art. In this case it is clear from McDermott that the desired color of the composition may include organic pigments for their desired color and intensity.

Applicants submit that McDermott teaches the eyelash color of claim 21, but state that claim 21 which claims eyelash color, eyeliner, cosmetic compositions for coloring eyebrows, a facial or body tattoo, or a lip color is not obvious over McDermott. McDermott teaches that "the present invention relates to cosmetic make-up compositions, particularly eye make-ups and mascaras," therefore, it would be obvious to the skilled artisan to make other colorants, such as eyeliner and lip colors because these colors are obvious variants of inventive eye make-ups.

Finally, applicants submit that McDermott teaches away from claims 26-29, because the limitations of said claims are not taught or suggested. The examiner respectfully disagrees. McDermott teaches that any optional ingredients known to those skilled in the art may also be used in the invention and specifically teaches silicas as such compositions. Furthermore, McDermott teaches water dispersible clays as being useful to thicken the water or oil phase of the compositions. Therefore, McDermott clearly makes the viscosity modifiers of instant claims 26-29 obvious additional ingredients to be included in the invention.

For Group II, claims 30-47, applicants argue that McDermott is nothing more than a general disclosure that various inorganic and organic pigments and be used in emulsion mascara compositions, but there is no teaching or

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suggestion that they contain both inorganic and organic pigments dispersed in the oil phase, with the organic pigments forming the main color component of the composition.

In response to applicants' assertion that McDermott is a general disclosure that various inorganic and organic pigments and be used in emulsion mascara compositions, the examiner respectfully agrees. McDermott teaches general concepts that are known in the art, such as adding organic pigments to a water-in-oil emulsion. Given the breadth of the instant claims, which include any water-in-oil emulsion having organic pigments as the main color component of the composition, a general disclosure makes the instant claims obvious.

Applicants argue that McDermott actually teaches away from the compositions of claims 30-47 because Examples I-V illustrate water-in-oil emulsion mascara compositions that contain black iron oxide, whereas claims 30-47 comprise both inorganic and organic pigments dispersed in the oil phase, with the organic pigments forming the main color component of the composition.

When considering the obviousness of modifying references, the examiner recognizes that obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, McDermott describes how "the make-up compositions of the present invention contain cosmetically acceptable pigments selected from the group of inorganic pigments, organic pigments, and pearlescent pigments."

Furthermore, the reference teaches that the pigments are present in proportions depending on the color and the intensity of the color which it is intended to produce." This suggests that the skilled artisan can easily and readily choose any desired pigments, including organic pigments with or without inorganic pigments, based on the color desired. Moreover, the reference clearly identifies organic pigment commonly used in cosmetic compositions. Although the water-in-oil emulsions in Examples I-V of the reference are do not contain both inorganic and organic pigments dispersed in the oil phase, with the organic pigments forming the main color component of the composition, the test for obviousness is not what is taught in the specific examples, as this would be a 102 rejection, not a 103 rejection, the test of obviousness is what the teaching would have suggested to one having ordinary skill in the art. In this case it is clear from McDermott that the desired color of the composition may include organic pigments for their desired color and intensity.

Applicants submit that McDermott teaches the eyelash color of claim 41, but state that claim 41 which claims eyelash color, eyeliner, cosmetic compositions for coloring eyebrows, a facial or body tattoo, or a lip color is not obvious over McDermott. McDermott teaches that "the present invention relates to cosmetic make-up compositions, particularly eye make-ups and mascaras," therefore making other colorants, such as eyeliner and lip colors obvious variants of the invention, as discussed above.

Finally, applicants submit that McDermott teaches away from claims 45-47, because the limitations of said claims are not taught or suggested. The

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examiner respectfully disagrees. McDermott teaches that any optional ingredients known to those skilled in the art may also be used in the invention and specifically teaches silicas as such compositions. Furthermore, McDermott teaches water dispersible clays as being useful to thicken the water or oil phase of the compositions. Therefore, McDermott clearly makes the viscosity modifiers of instant claims 45-47 obvious additional ingredients to be included in the invention.

For Group III, claims 48-65, applicants argue that there is nothing in McDermott that teaches or suggests the type of composition of instant claim 48. Specifically applicant argues that there is no teaching of a composition containing both organic and inorganic pigments, where the organic pigment is solubilized in the water phase and the inorganic pigment is dispersed in the oil phase and the organic pigments form the main color component of the composition.

In response to this argument the examiner agrees that McDermott does not specifically teach compositions comprising the both organic and inorganic pigments, where the organic pigment is solubilized in the water phase and the inorganic pigment is dispersed in the oil phase and the organic pigments form the main color component of the composition; however, the reference recognizes that both organic and inorganic pigments may be used in the compositions and that the pigments may have to be surface treated, depending on the pigments being used and the hydrophobic and hydrophilic properties of the composition. It is readily known in the art that in oil and water emulsions can have pigments in

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either the water phase or the oil phase, depending on which type of emulsion and which type of pigments are being used.

Applicants then argue that the examples of McDermott are directed to compositions containing iron oxide, it cannot be said that this reference teaches that organic pigments should form the main color component of the composition. The examiner respectfully disagrees. As discussed above the choice of pigment depends of the desired color and intensity of the color which it is intended to produce and it would be obvious to a skilled artisan to choose the organic pigments disclosed in McDermott for their desired colors and intensities.

Applicants then suggest the pigments and surface treated pigments of claim 49-50 are not obvious because they further define the pigments. However, McDermott teaches these pigments and the surface treatment of pigments with silicones, perfluorinated compounds, lecithin, and amino acids, therefore, these claims are also obvious in view of McDermott. Applicant then suggests that claims 52-53 further define the composition of claim 48 and that the examiner has used improper hindsight to arrive at the composition of claim 52-54.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In the instant case, McDermott teaches as a first essential component of the make-up composition is an insoluble polymeric material in an aqueous emulsion and that preferred oils are non-polar volatile hydrocarbons, therefore making the selection of volatile hydrocarbons at the very least, and obvious choice to the skilled artisan.

Applicants argue that the limitations of claim 58 are not taught or suggested by McDermott. The examiner respectfully disagrees. As stated by applicant, McDermott teaches eyelash color. Therefore, the limitation of claim 58 is met. However in response to applicants argument that other colors, eyeliner, cosmetic compositions for coloring eyebrows, a facial or body tattoo, or a lip color, were not suggested or taught by the reference, the examiner notes that the reference teaches "the present invention relates to cosmetic make-up compositions, particularly eye make-ups and mascaras," therefore, it would be obvious to the skilled artisan to make other colorants, such as eyeliner and lip colors because these colors are obvious variants of McDermott's inventive eye make-ups.

Applicant argues that the viscosity modifiers of instant claims 62-65 are not suggested by McDermott. The examiner disagrees. McDermott teaches that any optional ingredients known to those skilled in the art may also be used in the invention and specifically teaches silicas as such compositions. Furthermore, McDermott teaches water dispersible clays as being useful to thicken the water

or oil phase of the compositions. Therefore, McDermott clearly makes the viscosity modifiers of instant claims 62-65 obvious additional ingredients to be included in the invention.

For Group IV, claims 66-80, applicant argues that the examiner has used the instant specification as a guide and then picked the appropriate ingredients from McDermott to arrive at the composition as claimed because McDermott teaches a wide variety of pigments, but only exemplifies black iron oxide. Applicants further argue that it is clear from the teachings of McDermott that the inorganic pigments form part of the oil phase of the composition and therefore teaches away from the instant claims.

These arguments are not convincing for reasons analogous to those stated above. Namely, that when considering the obviousness of modifying references, to produce the claimed invention the motivation to do so may be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, McDermott describes how "the make-up compositions of the present invention contain cosmetically acceptable pigments selected from the group of inorganic pigments, organic pigments, and pearlescent pigments."

Furthermore, the reference teaches that the pigments are present in proportions depending on the color and the intensity of the color which it is intended to produce." This suggests that the skilled artisan can easily and readily choose any desired pigments, including organic pigments. Moreover, the reference clearly identifies organic pigment commonly used in cosmetic

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compositions and teaches that these pigments may be surface treated, therefore, realizing that these pigments can be added to both the hydrophobic and hydrophilic phases of the compositions. Although the reference teaches adding inorganic pigments to the oil phase, a skilled artisan clearly realizes that pigments may be added to either or both the water phase or the oil phase, a choice which is determined by the desired pigments used.

Applicants argue claims 70-72 further define film forming polymers and volatile components that further define the invention and one could only arrive at the composition of these claims by improper hindsight reconstruction using McDermott as a guide. The examiner agrees that McDermott would be used as a guide, but disagrees that it would be improper. As discussed above, In the instant case, McDermott teaches as a first essential component of the make-up composition is an insoluble polymeric material in an aqueous emulsion and that preferred oils are non-polar volatile hydrocarbons, therefore making the selection of volatile hydrocarbons at the very least, and obvious choice to the skilled artisan.

Applicants then argue that claim 75, which claims a silicone acrylate copolymer as the film forming polymer would not be obvious over McDermott because the film forming polymers of McDermott are different in chemical character in that they contain silicone moieties. Applicant is reminded that claim 75 was not rejected over McDermott alone.

Applicant then states that claims 79-80 are not obvious over McDermott for the same reasons as discussed with respect to claim 66. The examiner

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respectfully disagrees because McDermott teaches any optional ingredients known to those skilled in the art may also be used in the invention and specifically teaches silicas as such compositions. Furthermore, McDermott teaches water dispersible clays as being useful to thicken the water or oil phase of the compositions.

For Group V, claims 81-85, applicant argues that McDermott does not teach or suggest the compositions described in these claims and that the examiner has again used improper hindsight reconstruction to arrive at the composition as claimed instantly. These arguments are not convincing for reasons analogous to those described above. Namely, that when considering the obviousness of modifying references, to produce the claimed invention the motivation to do so may be found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, McDermott describes how "the make-up compositions of the present invention contain cosmetically acceptable pigments selected from the group of inorganic pigments, organic pigments, and pearlescent pigments."

Furthermore, the reference teaches that the pigments are present depend on the color and the intensity of the color which it is intended to produce. This suggests that the skilled artisan can easily and readily choose any desired pigments, including organic pigments. Moreover, the reference clearly identifies organic pigment commonly used in cosmetic compositions and teaches that these pigments may be surface treated, therefore, realizing that these pigments can be added to both the hydrophobic and hydrophilic phases of the

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compositions. Although the reference teaches adding inorganic pigments to the oil phase, a skilled artisan clearly realizes that pigments may be added to either, or both, the water phase and/or the oil phase, a choice that is determined by the desired pigments used.

For Group VI, claims 86-87, applicant argues that McDermott teaches away from such ingredients because the compositions of the examples contain both of these ingredients. The examiner respectfully disagrees. McDermott teaches waxes as optional ingredients, not that they must be present. Thus, waxes are not a necessary component of the compositions of McDermott, but they may or may not be added depending on the desired compositional characteristics desired.

Therefore the said rejection has been MAINTAINED.

Applicant's amendment and arguments filed June 26, 2002 (Paper No. 8), to the rejection of claims 1-21 and 22-87 under 35 U.S.C. 103(a) as being unpatentable over McDermott, **US 6,248,336 B1**, and further in view of Alkwattari et al., 5,985,258 and Krzysik 5,512,272 have been fully considered and deemed persuasive. Therefore, the said rejection has been withdrawn.

New Rejections

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 1-17, 21, 23-37, 41-54, 58-72, and 76-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah, WO 00/47168, and further in view of McDermott et al. 6,248,336.

Shah teaches long wearing cosmetic compositions for topical application to the skin that do not run or settle in the lines and creases of the skin. The reference teaches that the cosmetic compositions are particularly useful as eyeliners, or other eye or skin products. The reference teaches combining a acrylic acid or methacrylic acid derived polymer or copolymer and water soluble organic pigments to unexpectedly create a water resistant, long lasting film forming composition which can be applied to the skin. The primary reference teaches the specific organic pigments as claimed instantly and describes how it **may** be desirable to include small amounts of additional pigments such as inorganic pigments or combinations of organic and inorganic pigments. Therefore, the reference teaches compositions which may or may not contain inorganic pigments as color imparting ingredients in their invention. Furthermore, the Example of a Longwearing Cosmetic Composition on page 6 do not contain inorganic pigments. Moreover, the reference does not teach waxes or organic gelling agents in the composition, therefore, meeting the negative limitations of claim 86-87. Shah teaches that the compositions of the invention include any aqueous base that is miscible in water and can include glycerin and hydroalcohols, such as ethanol, propanol, and glycols, thus meeting the plasticizer limitation of instant claims 25, 42, 44, 61, and 78 as well as the volatile

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components of instant claims 16-17, 36-37, 53-54, 71-72, and 84-85. See: page 2, line 22 – page 6, line 35.

Although the primary reference teaches long lasting organic pigmented, film forming cosmetic compositions, which may further contain inorganic pigments, the primary reference lacks the specific water and oil emulsions as claimed instantly in claims 1-21 and 23-87, the copolymers of instant claims 18-20, 38-40, 55-57, and 73-75, the surface coating of pigments as claimed in claims 33, and 50, and the pigments comprised in specific phases as claimed instantly in claims 3-4 and 30-85.

McDermott teaches cosmetic make-up compositions, particularly eye make-up compositions, such as mascaras, in the form of aqueous emulsions. The emulsions are taught to comprising insoluble polymeric material in an aqueous emulsion or latex and a lipophilic oil. These emulsions are then used to produce mascaras with improved wear and water resistance and are removable with soap and water. See: col. 1, lines 4-68 and abstract.

McDermott describes how polymeric emulsions containing plasticizers and solvents are well known in the art and that these compositions contain thickeners including water-soluble and water-swellaable polymers typically used in the art. See: col. 1, lines 26-40.

The primary reference describes how the compositions of their invention can be fabricated into a multitude of forms such as water-in-oil and oil-in water-emulsions to make creams and pastes. Thus meeting the limitations of instant claims 1-2, 30, 48, 66, 81, and 86. The primary reference teaches that the

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proportion of pigments used depends on the color and intensity of the color desired and that the pigments are selected from inorganic pigments, organic lake pigments, pearlescent pigments, and mixtures thereof. McDermott describes how the pigments may be surface-treated and teaches the specific inorganic and organic pigments of instant claims 5-8, 13, 31-33, 49-50, 67-68, and 82-83. See: col. 6, lines 1-45.

The primary reference teaches that optional ingredients such as silica, mica, talc, polymethacrylate, polyethylene, and thickeners such as water dispersible clays, which meet the specific limitations of instant claims 26-29, 45-47, 62-65, and 79-80. See: col. 6, line 45 – col. 7, line 10. McDermott exemplifies as an object of the invention to provide a mascara composition which comprises an alkyl or alkoxy-dimethicone copolyol as well as the insoluble polymeric material in an aqueous medium. See: col. 2, line 1 – col. 5, line 4.

McDermott teaches the use of polar oils and volatile oils, which meet the volatile components of instant claims 15-17, 36-37, 53-54, 71-72, and 84-85. However, McDermott lacks the teaching of the phases in which the emulsions contain the pigments and the pigment colors of instant claims 9-12, 14, 30, 48, 66, and 81.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the long wearing organic pigmented composition of Shah by forming a water and oil emulsion as taught by McDermott because of the reasonable expectation of obtaining an emulsified organic pigment containing composition that can have surface coated pigments,

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which could be added to any desired phase and could contain pigments of any desired color.

Claims 1-21 and 22-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah, WO 00/47168, and McDermott et al. 6,248,336, and further in view of Calello et al., 5,849,275.

Although the combined references above teach an emulsified organic pigmented composition, which may further contain inorganic pigments, the references lack the specific copolymers of instant claims 18-20, 38-40, 55-57, and 73-75.

Calello et al., teach Glossy transfer resistant cosmetic compositions which can be incorporated into water and oil emulsions comprising a polymer, a volatile solvent, a nonvolatile oil, a dry particulate matter, and water. The tertiary reference teaches the specific silicone acrylate copolymers of instant claims 20, 40, 57, and 75 as being the most preferred polymers. The reference teaches that compositions comprising the polymer are long lasting, have a high gloss and shine and do not easily transfer to clothing or utensils. See: col. 1, lines 45-68; col. 4, lines 22-26; col. 6, line 52 – col. 7, line 7; col. 8, lines 29-45; and abstract.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the teaching of the combined references by adding the specific silicone acrylate copolymer of Calello et al., because of the expectation of obtaining an emulsified organic pigmented composition with an improved long lasting adherence to the skin and having a high gloss and shine.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clinton Ostrup whose telephone number is (703) 308-3627. The examiner can normally be reached on M-F (8:30am-5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marianne Seidel can be reached on (703) 308-4725. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Clinton Ostrup
Examiner
Art Unit 1614



October 23, 2002

